

S/N: 10/786,638

Atty Dkt No. GP-303365/GM0414PUSP

Remarks

The following remarks are intended to be fully responsive to the Office Action mailed February 10, 2006.

Claims 1-9 are pending. Claim 8 is withdrawn. Claims 1-5 and 7 are rejected under 35 U.S.C. §102(b) as being anticipated by Hunnicutt et al. (U.S. 6,494,804), hereinafter referred to as Hunnicutt. Claims 6 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hunnicutt.

Claims Rejection: 35 U.S.C. §102

Claims 1-5 and 7 are rejected under §102(b) as being anticipated by Hunnicutt.

Claim 1: With regard to claim 1, the Examiner states in part:

Hunnicutt et al. shows...a miniature electric motor 867 operatively connected to a moveable blocker 836 positioned in one of said passages for actuating movement of the blocker...”.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (emphasis added). See MPEP §2131.

Claim 1 is amended herein to clarify the presence of a clutch and a valve body, and in particular, that the “plurality of fluid passages further comprises at least one additional passage located external to said valve body”. (emphasis added). Support is found at Figure 3, which shows a clutch 40 and fluid passages 34, 36, and 38 separate from and external to valve body 24. Further support is found at paragraph [0023], which discloses in part, “...the transmission 20 includes...a valve body 24...fluid passage 32 directs fluid from the valve body 24 to the passages 34, 36, 38, which deliver the fluid to the clutch 40...”. In other words, fluid passages 34, 36, and 38, as shown in Fig. 3, are

S/N: 10/786,638

Atty Dkt No. GP-303365/GM0414PUSP

additional to passages 26 and 32 and at least one of those additional passages 34 is separate from and external to valve body 24. Claim 1 is further amended by language clarifying that the moveable blocker is positioned *in* the passage 34 located external to the valve body.

Hunnicutt does not teach the limitations of amended claim 1. In particular, the plurality of fluid passages 848 and 850, as well as actuator 867 and beam 866, are located entirely within valve body 825. See Hunnicutt Fig. 2. Hunnicutt therefore does not teach “at least one additional passage located external to said valve body” and “a moveable blocker positioned in said at least one additional passage...”, as required by amended claim 1. Amended claim 1 is therefore properly allowable.

Claims 2-5 and 7: Dependent claims 2-5 and 7 depend from amended claim 1, and are allowable for at least the same reasons as claim 1 is allowable. Additionally, amended claim 5 recites, in part, a “miniature motor...positioned in one of the passages and bathed in the fluid”, (emphasis added) as shown in Figures 1 and 2. The actuator 867 of Hunnicutt is not “positioned in one of the passages and bathed in the fluid.”

Claims Rejection: 35 U.S.C. §103

Claims 6 and 9 are rejected under §103(a) as being unpatentable over Hunnicutt. For a rejection to be proper under 35 U.S.C. § 103(a), the prior art reference or references must teach or suggest all of the claim limitations. MPEP § 2143. (emphasis added). A proper rejection under 35 U.S.C. §103(a) requires that the Examiner establish *prima facie* obviousness. As recited in the MPEP, “[t]he Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” MPEP §2142. Three basic criteria must be met to establish *prima facie* obviousness. MPEP §2142. First, there must be some suggestion or motivation to modify a reference or combine teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Third, the prior art reference or references must teach or suggest all the claimed limitations. *Id.*

S/N 10/786,638

Atty Dkt No. GP-303365 (GM-0414PUSP)

Claim 6: As to dependent claim 6, the Examiner states, in part, that “it would have been an obvious matter of design choice to make the actuator 867... have a width of 5mm and the length of 10mm, since such a modification would have involved a mere change in the size of a component.” As Hunnicutt does not disclose a size for its actuator 867, the limitations of claim 6 cannot be “a mere change in the size of a component.” Additionally, dependent claim 6 ultimately depends from independent claim 1. Regardless of size, the actuator of Hunnicutt does not teach “at least one additional (fluid) passage located external to (the) valve body...between...(the) valve body and...(the) clutch”, nor does it teach a “motor...positioned in said at least one additional passage”, as required by claim 1. Dependent claim 6 is therefore allowable for at least the same reasons as claim 1 is allowable.

Claim 9: Independent claim 9 contains limitations not found in dependent claim 6. In particular, claim 9 recites, in part, a “miniature motor positioned in said one of the passages and bathed in the fluid...”. As discussed pertaining to claim 5 above, this limitation is not taught or suggested by Hunnicutt, the actuator (867) of which is shown in Fig. 2 to be separate from any fluid passage, as compared to the motor 14 in Figs. 1 and 2 of the present invention. Moreover, the miniaturization of Applicant’s motor is more than an obvious design choice. This is so because the cooperation afforded by combining a miniature motor 14 within the confines of the fluid passage 10 results in a motor that is “bathed” in transmission fluid while being “operatively connected to a moveable blocker” in the passage. The technical advantage of such a cooperation is surely nonobvious over Hunnicutt. Accordingly, claim 9 is in condition for allowance.

#### Conclusion

This Amendment is believed to be fully responsive to the Office Action mailed February 10, 2006. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

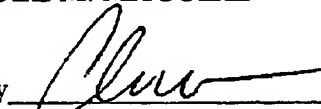
Respectfully submitted,

S/N 10/786,638

Atty Dkt No. GP-303365 (GM-0414PUSP)

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